Consistent with the election of Group I for prosecution, Applicant elects to prosecute claims that fall within Group B to SEQ ID No. 3 encoding SEQ ID No. 4, should no generic claim be allowable.

THE RESTRICTION REQUIREMENT

In order for restriction between two groups of claims to be proper, subject matter encompassed by the groups must be distinct **and** there must be a serious burden on the Office in examining the groups in the same application.

The propriety of the requirement as between Groups I and II

With respect to Group I and Group II, it is herein urged that the subject matter of each group is not distinct and that there is no burden on the Office in examining the claims in these groups in a single application.

Group I, claims 1-6 and 8-13, drawn to DNA encoding serine proteases and related subject matter, and Group II, claims 7 and 14-16, drawn to those serine proteases, are related as a product and DNA encoding same which is useful in making that product. As between inventions that are related in this manner, restriction is proper if the DNA may be used to make another materially different product, or if the product may be made from a materially different DNA. In addition, there must be a serious burden on the Office in examining the claims in the same application (see MPEP 803).

In this instance, the product cannot reasonably be made by another materially different DNA. In addition, the DNA cannot be used to produce a substantially different product.

Furthermore, whether or not the DNA and product claims are distinct, there is no serious burden on the Patent Office to examine the claims in the same application. The subclasses that are mandated for search for the DNA of Group I and the products of Group II are, if not identical, virtually co-extensive. As the Examiner is aware, merely indicating that the subject matter of two groups is classified in different

subclasses, does not mean that the searches are not co-extensive, since **mandated** searches for any product or DNA should encompass classes and subclasses in addition to that in which the product or method is classified. A search for the DNA of Group I would not be complete if limited to 435/352.3. Likewise, any search for the products would necessarily encompass subclasses that include DNA for encoding such products, since these patents could well disclose such products.

Although the particular subject matter of Group I and Group II are classifiable in different subclasses, the requisite searches are substantially co-extensive. Therefore, not only is the subject matter of each of Groups I and II not distinct, there would be no burden on the Office to search Groups I and II in a single application.

Furthermore, the Examiner's a attention is drawn to the claims of U.S. Patent No. 6,214,797 B1 (April 10, 2001) which was prosecuted by the undersigned and which contains claims to isolated DNA and to the peptides encoded by such DNA.

Finally, the Examiner is reminded that:

> [w]here inventions are related as disclosed but are not distinct as claimed, restriction is never proper. Since, if restriction is required by the Office double patenting cannot be held, it is imperative the requirement should never be made where related inventions as claimed are not distinct (see, MPEP 806, paragraph 3).

Reconsideration and withdrawal of the restriction requirement as between Groups I and II is respectfully requested.

Respectfully submitted,

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Attachment: Title Sheet and Claims of U.S. No. 6,214,797

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